SUPREME COURT, U. S.

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MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-1358

LOUIS W. PARKER,

Petitioner,

v.

MOTOROLA, INC.,

Respondent.

REPLY BRIEF TO RESPONDENT'S BRIEF

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The Respondent, Motorola, admits in its own brief that the Appellate Court's reversal of the District Court's decision is based on only non teaching documentary evidence (page 3, lines 31 to 33, and page 9, lines 28-29 of respondent's brief). The Appellate Court based its reversal on the "clearly erroneous doctrine". Yet this decision was made in the total absence of expert testimony as to obviousness, and in the total absence of any testimony by an electronic

expert, or any technical documentary evidence, showing the state of skill in the electronics art in 1950 (the time the invention was made), except for non teaching documentary evidence referred to hereinbelow. In the District Court trial, the Petitioner presented unrebutted testimony and unrebutted documentary evidence both as to unobviousness and as to the level of the skill in the art at the time of the invention which tended to show that the invention was unobvious, plaintiff's trial exhibit 14F. In *Graham v. John Deere Co.*, 383 US 1, 22-26 (1966), this Court required documentary evidence or testimony to show the state of the skill in the pertinent art at the time of the invention (1950). Failure to adhere to such a standard will result in decisions by courts which will be based on hindsight and will have no connection with the skill in the particular art at the time of the invention. This Court recognized that conjectural hindsight was not a proper perspective from which to determine patent ability since it would allow standards of patent ability to be set for inventions or improvements, which standards are unconnected with the then existing problems that faced a particular art at the time of the invention. It is inconceivable that the District Court's decision in this case could have been found to be "clearly erroneous", as required by Rule 52A of the Federal Rules of Civil Procedure, since there was a total lack of teaching documentary evidence or testimony as to obviousness, as well as a total lack of evidence by the Respondent, Motorola, as to the skill in the electronics art at the time of the invention in 1950, which would allow the Appellate Court to make proper inferences from non teaching documentary references.

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The Appellate Court erred in reversing the District Court's finding of validity because the trial record is entirely devoid of evidence upon which to support such a reversal. The Appellate Court erred by going beyond the trial record for electronic expertise and for evidence defining the skill in the art in 1950. The documentary evidence used by the Appellate Court consisted almost entirely of prior patents that were written for, and are only comprehensible to, those skilled in the art. Assuming, arguendo, that the Appellate Court had the technical expertise to fully comprehend the prior patents, how is it possible for the Appellate Court to draw inferences therefrom showing obviousness? There were no prior patents or documents which could serve as teaching references. Inference could only be drawn by one skilled in the electronics art in the particular time frame of the invention, that is, in 1950. The Appellate Court relied on application of Preda (CCPA, 1968), 401 F.2d 825, 159 USPQ 342; and Application of Kamm 1972, 452 F.2d 1052, 59 CCPA 753, 172 USPQ 298 for the proposition that a determination of obviousness may be based on "the inferences which one skill in the art would draw (from a plurality of references)." (Emphasis Added). These cited cases stand for the proposition that patent examiner is "one skilled in the art" whose expertise, at or near the time of the invention, i.e. during the prosecution of the patent application, is sufficient to allow him to draw inferences from a plurality of prior art references which lack a teaching reference to combine them. In the present case, there is absolutely no evidence that either the original examiner or, indeed, anyone "skilled in the art" ever drew inferences from the cited prior patents that the Appellate Courts assigned to the plurality of

references. The record in this case is totally devoid of such evidence. Thus, it is obvious that the Appellate Court itself assumed the role of "one skilled in the art" and drew inferences of obviousness from non teaching references. Thus the Appellate Court has essentially inserted its "expert opinion" into the void left by Respondent in the trial court record. As such, the Appellate Court has effectively denied the Petitioner his right to confront and cross-examine hostile experts and has relieved the Respondent of the statutorily imposed burden of proof. This Court must not sanction such action by denial of Petitioner's petition.

Further, the Appellate Court simply ignored the District's findings 23 through 31 and 33 which stated critical technical distinction between the references cited in support of obviousness and the subject matter of the patent's claims. There is no support for the Appellate Court's disregard of these critical technical distinctions when drawing its internally generated inferences and once again when utilized these uncited prior art references to reduce the presumption of validity. In order to reduce the presumption of validity, the Appellate Court must necessarily have concluded that the uncited prior art references were more pertinent than those cited by the patent office examiner. There is no evidence stating that these references are more pertinent than those cited by the examiner in the trial records. There is evidence to the contrary.

The Respondent, Motorola, did not come to grips with the full import of the question relating to the Appellate Court's denial of the presumption of validity of Claim 14. The Appellate Court in this case removed the final vestige of the Petitioner's presumption of validity by reason or alleged errors which occurred

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during the amendment of certain of the claims. However, as Respondent well knows, Claim 14 was never amended. It cannot, therefore, suffer from the same alleged infirmities as the other amended claims. Nevertheless, Claim 14 was swept away with no mention of the distinction between it and the other claim.

Rule 52A prevents the Appellate Court from interposing itself and technical experts in order to supply inference evidence not found in the trial record and from substituting itself for the electronic experts, the function of which expert is to provide evidence and to the state of the art at the time of the invention.

Virtually all devices may be considered combinations of known elements if a sufficiently broad definition of the particular combination is chosen. Patents are provided for under 35 USC 101 as a matter of rights for "inventions" and "improvements thereof" an improvement, by definition, cannot give rise to a new result, but can only make the old elements function in a more efficient manner. Novel and useful improvements are patentable if found to be unobvious under 35 USC 103. The invention or improvement in this case is defined solely by the claims. The claimed circuit provides an improved tuning capability for vestigial sideband intercarrier television circuits (admittedly never done before in the prior art) in a manner that was unobvious to those skilled in the art at the time of this invention (1950). All of these conclusions which were proven by the unrebutted evidence of the Petitioner's witnesses as well as documentary evidence.

Respondent, Motorola, in its brief, does not address itself to the legal definition of the invention as specified in the claims, which are analogous to the metes and

bounds in a land deed, but merely resorts to cant and catch phrases to support its position as it previously did on appeal. Respondent, Motorola, did not directly attack the claims at trial. Respondent's strategy throughout this case has always been to confuse the true issues by resort to obfuscation. For example, the word "superhetrodyne circuit" is not part of Claims 3, 14 or 17 of the Petitioner's patent. The Respondent, Motorola, refers to the immateriality and irrelevancy of the vestigial sideband intercarrier television circuitry, without supportive testimony. There is unrebutted evidence to the contrary. The vestigial sideband intercarrier television presented an array of signals that at the time of the invention in 1950 did not present a single signal which was obvious to use as a means for indicating (Exhibit 14F).

The Respondent throughout the history of this case has attempted to cloud the real issues by characterizing the invention merely a "receiver and indicating means". Such an attempt completely disregards the legal definition of the invention as specified in the claim. This is comparable to ignoring the metes and bounds description in a land deed in a real estate dispute. The specific claims are to a vestigial sideband intercarrier television receiver, a means for indicating, and a claimed connection between the two at a particular point in a complex wave pattern (among the many other points that might have been used to obtain a usable signal that were subsequently discovered and shown by the trial exhibits including subsequent non-infringing Motorola patents for vestigial sideband intercarrier television).

Therefore, if the invention is to be categorized as a combination, it is not a combination of a "receiver and indication means". The invention as outlined by the

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legal description, i.e. the claims, is a vestigial sideband intercarrier television, means for indicating and each and every connecting element claimed.

The question is whether or not the Appellate Court had any evidence before it to properly support its reversal of the District Court's decision. The question is not what evidence the Petitioner produced at trial. The questions presented by this appeal are questions of law and not fact.

The Court of Appeals in this case effectively has assumed the role of "one skilled in the art" and has thereby denied the Petitioner the right of cross-examination of the alleged expert who draws inferences on the bases of which Petitioner's invention is held to be obvious. The Appellate Court must not be allowed to draw inferences from technical electronics documents since such a role is properly reserved for those "skilled in the art". This is true especially where, as here, no such inferences were drawn by the experts at trial. Furthermore, when the inference of obviousness must be related to the state of the art at the time the invention was made and where the preponderance of the testimony and documentary evidence of record is in the Petitioner's favor and where the Respondent produced no teaching reference to combine the several prior art references, the Appellate Court should be reversed. This Court must not allow the Appellate Court to substitute its option as to obviousness for the factual determination of the trial court without showing under the

clearly erroneous doctrine that the trial court has demonstrably erred.

Respectfully submitted,

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